

**REMARKS**

In the Office Action,<sup>1</sup> the Examiner took the following actions:

- 1) rejected claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0065774 to Steiner et al. ("*Steiner*") in view of U.S. Patent No. 6,625,595 to Anderson et al. ("*Anderson*"); and
- 2) rejected claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Steiner* in view of *Anderson* and U.S. Patent No. 6,327,590 to Chidlovskii et al. ("*Chidlovskii*").

**Rejection of Claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over *Steiner* in view of *Anderson*. A *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art (taken separately or in combination) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

A *prima facie* case of obviousness has not been established because, among other things, the prior art fails to teach or suggest each and every element of Applicants' claims.

Independent claim 1 recites "[a]n information service search support apparatus comprising . . . search condition item extracting means for . . . notifying the agent of . . . the result of the search." The Examiner continues to argue that *Steiner* teaches this claim element. This is not correct.

Applicants previously explained that, in *Steiner*, the resource provider delivers the search results to the resource requester. See Amendment filed March 27, 2007, page 9. The Examiner acknowledges this teaching of *Steiner*, stating that "the original resource requestor . . . receives the search results from the resource provider[]." Office Action, page 8.

To clarify the distinction between *Steiner* and Applicants' claims, consider the claimed "information service search apparatus" (comprising the search condition item extracting means) as *A*; the claimed "information service" as *B*; the claimed "agent" as *C*; *Steiner's* search broker as *A'*; *Steiner's* resource provider as *B'*; and *Steiner's* resource requester as *C'*.

Claim 1 recites "[a]n information service search support apparatus [*A*] comprising . . . search condition item extracting means for . . . notifying the agent [*C*] of . . . the result of the search." That is, the result of the search is notified by *A* to *C*. However, in *Steiner*, "[t]he resource provider[] [*B'*] deliver[s] the search results directly to the original requester [*C'*]." *Steiner*, para. 0041. That is, in *Steiner*, the result of the search is notified by *B'* to *C'*. The notification of the search results by *B'* to *C'* in *Steiner*

cannot constitute a teaching of a notification of the search results by A to C, as claimed. In other words, *Steiner*'s disclosure of "[t]he resource provider[] deliver[s] the search results directly to the original requester" cannot constitute a teaching or suggestion of the claimed "search condition item extracting means for . . . notifying the agent of . . . the result of the search," as recited in claim 1. Therefore, *Steiner* fails to teach or suggest the "search condition item extracting means" of claim 1.

Furthermore, *Anderson* fails to cure the above-noted deficiencies of *Steiner*. That is, *Anderson* also fails to teach or suggest "search condition item extracting means for . . . notifying the agent of . . . the result of the search," as recited in claim 1.

For at least the reasons given above, the prior art, taken separately or in combination, fails to teach or suggest each and every element of independent claim 1. For at least this reason, no *prima facie* case of obviousness can be established for claim 1.

Furthermore, independent claims 6 and 11, although different in scope from claim 1, are also allowable over *Steiner* and *Anderson* for at least reasons similar to those given above for claim 1. In addition, dependent claims 2, 3, 7, 8, 12, and 13 are allowable over *Steiner* and *Anderson* at least by virtue of their dependence from allowable base claims 1, 6, and 11. Therefore, a *prima facie* case of obviousness with respect to claims 1-3, 6-8, and 11-13 has not been established. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a).

**Rejection of Claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable over *Steiner* in view of *Anderson* and *Chidlovskii*. A *prima facie* case of obviousness has not been established because, among other things, the prior art, taken separately or in combination, fails to teach or suggest each and every element of Applicants' claims.

As noted above, *Steiner* and *Anderson* fail to teach all the elements of independent claims 1, 6, and 11. *Chidlovskii* fails to cure this deficiency. That is, *Chidlovskii* also fails to teach or suggest "search condition item extracting means for . . . notifying the agent of . . . the result of the search," as recited in claim 1, and required by dependent claims 4, 5, 9, 10, 14, and 15. For at least this reason, the prior art, taken separately or in combination, fails to support a *prima facie* case of obviousness with respect to claims 4, 5, 9, 10, 14, and 15. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a).

**Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

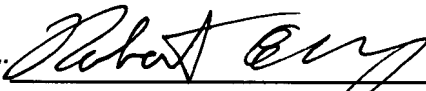
Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:

 #27432  
Richard V. Burgujian  
Reg. No. 31,744  
*for*